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| 10/812,700  | 03/30/2004  | Ram Asokan           | 9314-70             | 4087             |
| 54414 7590 08/17/2009<br>MYERS BIGEL, SIBLEY & SAJOVEC, P.A.<br>P.O. BOX 37428<br>RALEIGH, NC 27627 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| BATISTA, MARCOS   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2617  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/812,700

**Applicant(s)**

ASOKAN, RAM

**Examiner**

MARCOS BATISTA

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6, 8, 9, 11, 27, 29, 31, 32, 34 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8, 9, 27, 29, 31, 32, 34, 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to Applicant's amendment filed on 06/10/2009. Claims 2-6, 8, 9, 11, 27, 29, 31, 32, 34, 36-39 are still pending in the present application. This Action is made **NON-FINAL**.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/10/2009 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 2, 26, 27, 28, 29 and 36 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Election/Restrictions***

4. Amended claim 11 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 11 is drawn to push-to-talk session for suspending a push-to-talk session and notifying a server that the session has been suspended and reestablishing the session, classified in class 455, subclass 518.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claim 11 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2-5, 8, 9, 27, 29, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Bhattacharya (US 20030028602 A1), hereafter "Bhattacharya."

Consider claim 2, Koskinen discloses a wireless terminal participating in a packet-switched communication session to provide notice of receipt of an incoming circuit-switched call, the method comprising: **(see fig. 1a, col. 7 lines 28-32 and 56-58, col. 8 lines 1-13):** receiving a paging request associated with the incoming circuit-switched call **(see col. 7 lines 32-56)**; and notifying a server that establishes and runs

the packet-switched communications session that the wireless terminal has received the incoming circuit switched call (**see col. 7 line 58, col. 8 lines 1-13**).

Koskinen, however, does not particular refer to wherein notifying the server that establishes and runs the packet-switched communications session with at the wireless terminal has received the incoming circuit switched call comprises forwarding a notification message from the wireless terminal to the server over a circuit-switched channel.

Bhattacharya, in the same field of endeavor, teaches transmitting a notification message from the wireless terminal to the server over a circuit-switched channel (see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2 – Bhattacharya discloses a mobile terminal transmitting an SMS message over the GSM network to a message center server to inform the server about an action to be taken regarding stored messages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include transmitting a notification message from the wireless terminal to the server over a circuit-switched channel, as taught by Bhattacharya. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (*see par. 0013 lines 1-10*).

Consider claim 3, Koskinen as modified by Bhattacharya discloses the invention of claim 2 above. Koskinen also discloses wherein the incoming circuit-switched call

comprises a circuit-switched call transmitted over a GSM network (see col. 1 lines 37-42, col. 6 lines 22-29). Bhattacharya also teaches wherein the circuit-switched channel is the SMS data bearer (see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2). The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (*see par. 0013 lines 1-10*).

Consider claim 4, Koskinen as modified by Bhattacharya discloses the invention of claim 3 above. Bhattacharya also teaches wherein the notification message comprises a text message (see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2). The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (*see par. 0013 lines 1-10*).

Consider claim 5, Koskinen as modified by Bhattacharya discloses the invention of claim 3 above. Koskinen also discloses wherein the notification message is forwarded via an IP level connection over the SMS data bearer (see col. 1 lines 37-42).

Consider claim 8, Koskinen as modified by Bhattacharya discloses the invention of claim 2 above. Koskinen also discloses notifying the server that establishes and runs the packet-switched communications session upon termination of the incoming circuit-switched call (see col. 9 lines 41-47).

Consider claim 9, Koskinen as modified by Bhattacharya discloses the invention of claim 8 above. Bhattacharya also teaches wherein the notification forwarded upon termination of the incoming circuit-switched call is forwarded over a circuit-switched channel (see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2). The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (see *par. 0013 lines 1-10*).

Consider claim 27, Koskinen discloses a wireless communication terminal comprising: a transceiver; a packet-switched suspension notification circuit coupled to the transceiver that is configured to generate a notification message for transmission to a server controlling a packet-switched communications session when the wireless temporarily suspends participation in the packet-switched communications session (**see col. 7 line 58, col. 8 lines 1-13, col. 1 lines 37-42**); and a circuit-switched communications circuit, wherein the packet-switched suspension notification circuit generates the notification message in response to receipt of a circuit-switched page by the circuit-switched communications circuit (**see fig. 2a, col. 7 lines 56-58, col. 8 lines 1-13**).

Koskinen, however, does not particular refer to a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer.

Bhattacharya, in the same field of endeavor, teaches a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer

(see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2 – Bhattacharya discloses a mobile terminal transmitting an SMS message over the GSM network to a message center server to inform the server about an action to be taken regarding stored messages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include a notification message that is suitable for transmission as a text message over a circuit switched SMS data bearer, as taught by Bhattacharya. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (*see par. 0013 lines 1-10*).

Consider claim 29, this claim discusses the same subject matter as claim 27. Therefore, it has been analyzed and rejected based upon the rejection to claim 27.

Consider claim 36, Koskinen discloses a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising (**see fig. 1a, col. 7 lines 28-32 and 56-58, col. 8 lines 1-13**): receiving a paging request associated with the incoming circuit-switched call (**see col. 7 lines 32-56**); notifying a server associated with that establishes and runs the packet-switched communications session that the wireless terminal has received the incoming circuit switched call (**see col. 1 lines 37-42, col. 7 line 58, col. 8 lines 1-13**); wherein the incoming circuit-switched call comprises a



circuit-switched call transmitted over a GSM network (**see col. 1 lines 37-42, col. 6 lines 22-29**).

Koskinen, however, does not particular refer that notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a notification message from the wireless terminal to the server that establishes and runs the packet-switched communications session via a text message

Bhattacharya, in the same field of endeavor, teaches notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a notification message from the wireless terminal to the server via a text message (see fig. 1, abstract, pars. 0035 lines 1-4, 0042 lines 1-6, 0041 line 1 - 0052 line 2 – Bhattacharya discloses a mobile terminal transmitting an SMS message over the GSM network to a message center server to inform the server about an action to be taken regarding stored messages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen and have it include notifying a server is performed over a circuit switched SMS data bearer channel; forwarding a notification message from the wireless terminal to the server via a text message, as taught by Bhattacharya. The motivation would have been in order to facilitate the transmission of a message over a communication network that is widely preferable by network operators (*see par. 0013 lines 1-10*).

8. Claims 6 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Bhattacharya (US 20030028602 A1), hereafter "Bhattacharya," further in view of Nasielski et al. (US 20050041640 A1), hereafter "Nasielski."

Consider claim 6, Koskinen as modified by Bhattacharya discloses the invention as in claim 2 above.

Koskinen, however, does not particular refer to wherein the notification message includes an identification associated with the wireless terminal.

Nasielski, in analogous art, teaches a notification message that includes an identification associated with a wireless terminal (see par. 0032 lines 6-9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Bhattacharya and have it include a notification message that includes an identification associated with a wireless terminal, as taught by Nasielski. The motivation would have been in order to determine the proper routing of the call (see par. 0032 lines 6-9).

Consider claim 39, Koskinen as modified by Bhattacharya discloses the invention as in claim 36 above. Koskinen, however, does not particular refer to wherein the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of the incoming circuit-switched call.

Nasielski, in analogous art, teaches wherein the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of

the incoming circuit-switched call (see par. 0032 lines 6-9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Bhattacharya and have it include wherein the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of the incoming circuit-switched call, as taught by Nasielski. The motivation would have been in order to determine the proper routing of the call (see par. 0032 lines 6-9).

11. Claims 31, 32, 34, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen et al. (EP 1096813 A2), hereafter "Koskinen," in view of Bhattacharya (US 20030028602 A1), hereafter "Bhattacharya," further in view of Levy et al. (US 20040142694 A1), hereafter "Levy."

Consider claim 31, Koskinen as modified by Bhattacharya discloses the invention as in claim 2 above.

Koskinen, however, does not particular refer to wherein the packet-switched communication session comprises a push-to-talk session.

Levy, in analogous art, teaches a packet-switched communication session comprises a push-to-talk session (see pars. 0002 lines 1-5, 0011 lines 8-17, 0012 lines 1-2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Bhattacharya

and have it include a packet-switched communication session comprises a push-to-talk session, as taught by Levy. The motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

Consider claim 32, Koskinen as modified by Bhattacharya and Levy discloses the invention as in claim 31 above. Koskinen also discloses wherein notifying the server associated with the packet-switched communication session that the wireless terminal has received the incoming circuit-switched call includes notifying the server that wireless terminal has suspended the push-to-talk session (see col. 7 lines 56-58, col. 8 lines 1-13).

Consider claim 34, Koskinen as modified by Bhattacharya and Levy discloses the invention as in claim 32 above. Koskinen also discloses wherein the circuit-switched channel is the SMS data bearer (see col. 1 lines 37-42, col. 6 lines 22-29).

Consider claim 37, Koskinen as modified by Bhattacharya discloses the invention as in claim 36 above. Koskinen also discloses resuming the push-to-talk session under the existing Packet Data Protocol context after termination of the circuit-switched call (see col. 8 lines 3-7).

Koskinen, however, does not particular refer to wherein the packet-switched communications session comprises a push-to-talk session, wherein the server

associated with the packet-switched communications maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call.

Levy, in analogous art, teaches wherein the packet-switched communications session comprises a push-to-talk session, wherein the server associated with the packet-switched communications maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call (see pars. 0019 lines 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Koskinen as modified by Bhattacharya and have it include wherein the packet-switched communications session comprises a push-to-talk session, wherein the server associated with the packet-switched communications maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call, as taught by Levy. The motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

Consider claim 38, Koskinen as modified by Bhattacharya and Levy discloses the invention as in claim 37 above. Levy also teaches notifying a remote wireless terminal that is part of the push-to-talk session that the wireless terminal has temporarily suspended participation in the push-to-talk session (see par. 0012 lines 17-22). The

motivation would have been in order to inform users engaged in a communication session about a service interruption so that they can properly re-establish the session (see par. 0003 lines 9-21).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached at (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

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*/Marcos Batista/*  
Examiner

*/Rafael Pérez-Gutiérrez/*  
Supervisory Patent Examiner, Art Unit 2617

08/12/2009